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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/283,431 04/01/99 ZHOU

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EXAMINER

LACOURCIERE, K

ART UNIT

PAPER NUMBER

1635

DATE MAILED:

06/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/283,431

Applicant(s)

Zhou et al.

Examiner

Karen A. Lacourciere

Group Art Unit

1635



☒ Responsive to communication(s) filed on Apr 17, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 4-6 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 4-6 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 6, 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

New Grounds of Rejection

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-6 are indefinite due to the recitation "one or more POPS blocks". "POPS blocks" have been defined as regions of alternating phosphodiester and phosphorothioate internucleoside linkages. As defined, a single "POPS block" does not have a specified length and, as such, one skilled in the art would not be able to differentiate between a single "POPS block" and a series of "one or more" contiguous "POPS blocks".

Claims 4-6 are further indefinite due to the recitation "flanked". As written, one skilled in the art would not be able to determine if each individual "POPS block" is flanked by one or more regions of 2'-O-modified regions or if the "POPS blocks" are contiguous, resulting in a core region of "POPS" flanked by one or more 2'-O-modified regions.

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Therefore, one skilled in the art would not be able to determine the metes and bounds of the oligonucleotides claimed in claims 4-6.

Response to Arguments

3. Applicant's arguments filed 04/17/00 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the exclusion of methyphosphonate internucleoside linkages in the 2'-O-modified flank regions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold et al.

New claims 4-6 recite an oligonucleotide consisting of one or more POPS blocks flanked by 2'-O-modified regions. As written, there is no recitation which limits the type of

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internucleoside linkage in the 2'-O-modified regions of the claimed oligonucleotide. As such, the oligonucleotides disclosed by Arnold et al. (see, for example p 87, compounds 3336-1 and 3339-1) include a 20-mer and a 24-mer which consist of a core region of alternating phosphodiester and phosphorothioate bonds flanked by regions of 2'-O-methyl modified nucleosides. As such, Arnold et al. anticipates claims 4-6.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (703) 308-7523.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott can be reached at (703) 308-4003. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere

June 21, 2000

Remy Yucel
REMY YUCEL, PH.D
PRIMARY EXAMINER